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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/851,539	05/07/2001	William Willett	MAT 3D7	2596

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EXAMINER

SUHOL, DMITRY

ART UNIT	PAPER NUMBER
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3712

DATE MAILED: 12/19/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/851,539

Applicant(s)

WILLETT, WILLIAM

Examiner

Dmitry Suhol

Art Unit

3712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6, 18-25 and 34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-6 and 34 is/are allowed.
- 6) ☒ Claim(s) 18-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 080403. 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 18-25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "not proportional" in claim 18 is a relative term which renders the claim indefinite. The term "not proportional" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. In other words the sizes of the head, base and body have been rendered indefinite due to the use of the relative term "not proportional".

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 18-19, 21-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Del Castillo et al '548 in view of Fong '043 and Robbins '907. Del Castillo discloses

some of the elements of the claims including a motor assembly having a motor as required by claim 19 (fig. 10c, element 740) which is used to control the movement of a doll's (60) head and it's related portions (fig. 1) as required by claim 18, wherein the doll has a base which resembles feet (figure 1 and cols. 4-5, lines 65+ and 1-3, respectively). Del Castillo further teaches a head position assembly (figs. 1 and 10a-10c) interposed between the head and the body (figure 1, element 69 and col. 2, lines 49-51) wherein the head rotates about the head position assembly while the head position assembly remains generally stationary in relation to the body (figure 10a) where the servo 650 remains in position while the head rotates around it through the movement of element 775, as required by claim 21. A position monitoring structure, as required by claim 22, is shown in fig. 10b as element 654. A biasing structure, as required by claim 23, is shown in fig. 10c as element 760 and described in col. 20-21, lines 61+ and 1-3, respectively.

The reference fails to teach a base configured to disguise a power source as required by claim 18, a body mounted on the base having a size that is not proportional to the base as required by claim 18, a head having a size that is not proportional to the body size as required by claim 18, the base being adapted to provide a counter-weight to support the head in an upright position, as required by claims 24 and 25. However, Fong discloses an animated doll, which teaches a base shaped to resemble feet (elements 36) configured to disguise a power source (figure 3). Robbins teaches that it is known to provide a doll having a body of a size that is not proportional to the base (figures 1 and 2) and a head of a size that is not proportional to the body size (figures 1 and 2) so that the doll may stand on the feet (col. 1, lines 68-69). Therefore, in view of

Fong, it would have been obvious to one having ordinary skill in the art, at the time of the claimed invention, to disguise a power source in a base resembling feet for the purpose of hiding a power source in an easily reachable location. It would have been further obvious to provide the doll of Del Castillo with a body of a size that is not proportional to the base and a head of a size that is not proportional to the body size for the purpose of stability and added ability to show facial features in order to make the doll easily recognizable.

Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Del Castillo et al '548, Fong '043 and Robbins '907 in view of May et al '289. Del Castillo, as modified by Fong and Robbins, discloses all the elements of the claims, as stated above, and further including a servo motor and clutch system for movement of eyes (col. 2, lines 49-51) however the reference fails to explicitly teach the movement of eyelids as required by claim 20. May discloses a mechanism for animating a doll's facial features, which teaches that it is known to provide an animated doll with moveable eyelids (col. 3, lines 52-53). Therefore it would have been obvious to provide the doll of Del Castillo, as modified by Fong and Robbins, with moveable eyelids especially since Del Castillo envisions his mechanical assembly utilized for movement of a variety of a doll's features including eyes.

Allowable Subject Matter

Claims 1-6 and 34 are allowed.

Response to Arguments

Applicant's arguments with respect to claims 18-25 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dmitry Suhol whose telephone number is 703-305-0085. The examiner can normally be reached on Mon - Friday 9am-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on 703-308-1745. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

A handwritten signature in black ink, appearing to read 'D. Banks', with a long horizontal line extending to the right.

ds

DERRIS H. BANKS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700